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| 10/659,262      | 09/11/2003  | Takahiro Moro        | 00862.001703.2      | 3540             |

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EXAMINER

POON, KING Y

ART UNIT PAPER NUMBER

2625

DATE MAILED: 11/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/659,262

**Applicant(s)**

MORO ET AL.

**Examiner**

King Y. Poon

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 87-101 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 87-101 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 08/768,579.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/25/2006</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/8/2006 has been entered.

### ***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "a first determination unit, adapted to determine whether or not the instruction to print is accepted; a second determination unit, adapted to determine whether or not a setting value of a first setting item in the window is changed when the instruction to print is determined to be not accepted by said first determination unit;" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet,

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and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 87-101 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims are directed to fig. 31; fig. 31 does not appear to disclose "a first determination unit, adapted to determine whether or not the instruction to print is accepted; a second determination unit, adapted to determine whether or not a setting value of a first setting item in the window is changed when the instruction to print is

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determined to be not accepted by said first determination unit." Fig. 31, at the most, disclosed determining whether or not the instruction to print is designated, not accepted.

Therefore, the limitations of "a first determination unit, adapted to determine whether or not the instruction to print is accepted; a second determination unit, adapted to determine whether or not a setting value of a first setting item in the window is changed when the instruction to print is determined to be not accepted by said first determination unit" is subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 88, 93, 98 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 88, 93, 98: Claims 87, 92, 97 is claiming "when it is determined that the user is not allowed to instruct to change the setting value of the second setting item, change the setting value of the second setting item corresponding to the changed setting value of the first setting item without displaying the window on which the user is allowed to instruct to change the setting value of the second setting item."

Claims 88, 93, 98; depend on claims 87, 92, 97; is claiming "when it is determined that the user is not allowed to instruct to change the setting value of the second setting item, said change unit does not change the setting value of the second setting item corresponding to the changed setting value of the first setting item."

The applicant is require to particular point out whether the system, when it is determined that the user is not allowed to instruct to change the setting value of the second setting item; the system; 1) change the setting value of the second setting item corresponding to the changed setting value of the first setting item, or 2) not change the setting value of the second setting item corresponding to the changed setting value of the first setting item."

### ***Claim Rejections - 35 USC § 101***

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 97-101 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 97-101 are drawn to functional descriptive material embodied on a computer readable medium (i.e., "data structures and computer programs which impart functionality when employed as a computer component" at MPEP 2106.IV.B(1)). However, the program/algorithm itself merely manipulates data or an abstract idea, or merely solves a mathematical problem without a limitation to a practical application in the technological arts. MPEP 2106.IV.B.2(a) (Statutory Product Claims) states:

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In order for a claimed invention to accomplish a practical application, it must produce a "useful, concrete and tangible result" *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601-02 (see MPEP 2106.II.A). Currently, the claim does not recite a practical application. In order for the claimed product to produce a "useful, concrete and tangible" result, recitation of one or more of the following elements is suggested: A computer-readable medium encoded with a program...

"In contrast, a claimed computer-readable medium encoded with the data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory." - MPEP 2106.IV.B.1(a)

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 87, 92, 97 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hower, Jr. et al (US 5,467,434) in view of DeHority (US 5,267,727).

Regarding claims 87, 92, 97: Hower teaches an information processing apparatus (fig. 2) comprising: a display unit (column 4, lines 15-25), adapted to display a window for accepting a setting (print job settings, column 4, lines 25-20) for a printer driver (the program that allows a user to interface with the printer such as allowing a user to program a print job, column 4, lines 10-28) and an instruction to print (options, of

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fig. 4, fig. 5); a first determination unit (the software that determines the print options are acceptable, column 5, lines 40-60), adapted to determine whether or not the instruction to print is accepted; an issuance unit (the software that submits the job ticket, column 7, lines 30-32), adapted to issue a control command (job ticket) based upon the setting to a printer when the instruction to print is determined to be accepted by said first determination unit; a second determination unit, adapted to determine whether or not a setting value of a first setting item in the window is changed (see fig. 4, user is allow to select different, size, clearly the system must be able to determine the input of e.g., 8.5x14 to 8.4x14 such that paper stock would be correctly displayed, fig. 4) when the instruction to print is determined to be not accepted by said first determination unit (the display of impermissible choice of column 7, lines 40-55 is obvious that it is telling the user that the original selection is not allowed and to allowed the user to reprogram the selections if the user wants to print the print job; also see column 1, lines 50-55); a change unit (the program that display LOGO, Plain, column 7, lines 45-50 such that the user can instruct the change to LOGO corresponding to the change of paper size, fig. 11), adapted to, when it is determined that the user is allowed to instruct to change the setting value of the second setting item (the system is using the user change method of changing LOGO or PLAIN or TAB to match the selected paper size, fig. 11, column 7, lines 45-50) display a window on which the user is allowed to instruct to change the setting value of the second setting item and, when the user instructs to change the setting value of the second setting item, change the setting value of the second setting item corresponding to the changed setting value of the first setting item, or when it is



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determined that the user is not allowed to instruct to change the setting value of the second setting item (the system is using the automatically substitute method of changing LOGO or PLAIN or TAB to match the selected paper size, fig. 11, column 7, lines 50-55), change the setting value of the second setting item corresponding to the changed setting value of the first setting item without displaying the window on which the user is allowed to instruct to change the setting value of the second setting item.

Hower does not teach a third determination unit, adapted to, when the setting value of the first setting item is determined to be changed by said second determination unit, determine whether or not to allow a user to instruct to change a setting value of a second setting item corresponding to the changed setting value of the first setting item.

DeHority, in the same area of changing user selected instruction of a print job such that user's print job would be successfully carried out, teaches a determination unit, adapted to, when the setting value of the first setting item is determined to be changed by said second determination unit (the program of the print job, column 2, lines 50-67), determine whether or not to allow a user to instruct to change a setting value of a setting items (column 3, lines 50-55; notified user=user allowed to change, substitute=user not allowed to change at the time of substitution).

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Hower to include: a third determination unit, adapted to, when the setting value of the first setting item is determined to be changed by said second determination unit (change of the paper size of Hower), determine whether or not to allow a user to instruct to change a setting value

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of a second setting item corresponding to the changed setting value of the first setting item (the examiner of Hower determines that the paper size selected is mismatch with the LOGO Plain Tab selection of column 7, lines 35-55).

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Hower by the teaching of DeHority because: 1) it would provide flexibility to the system, column 1, lines 40-45, DeHority; 2) it would not have wasted user's time, column 1, lines 40-45, DeHority; and 3) it is advantages of doing so, column 2, lines 30-35, DeHority.

Regarding claims 89, 94, 99: Hower teaches acquisition unit, adapted to acquire link information (the software that is accessing the rules about combination of print instructions selection, column 5, lines 40-67, column 6) regarding the changed setting when the setting value of the first setting item is determined to be changed.

Regarding claims 90, 95, 100: Hower teaches wherein the link information contains information instructing that a first value of the second setting item is unable to be changed and information instructing that a second value of the second setting item is selected (impermissible combination, column 7, lines 35-40).

Regarding claims 91, 96, 101: Hower teaches an acquisition unit, adapted to acquire link information (the software that is accessing the rules about combination of print instructions selection, column 5, lines 40-67, column 6) regarding the changed setting when the setting value of the first setting item is determined to be changed; and a comparison unit, (column 7, line 35-36) adapted to compare the link information acquired by said acquisition unit and a setting, wherein said change unit changes the

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setting value of the second setting item corresponding to the changed setting value of the first setting item if the link information differs from the setting (substitute automatically, column 7, lines 50-55).

### ***Response to Arguments***

10. Applicant's arguments with respect to claims 87-101 have been considered but are moot in view of the new ground(s) of rejection. Please see detailed office action.

### ***Conclusion***


11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to King Y. Poon whose telephone number is 571-272-7440. The examiner can normally be reached on Mon-Fri 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on 571-272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

November 10, 2006

  
KING Y. POON  
PRIMARY EXAMINER